

REMARKS

Claim 1 through 133 are present in this application present

The outstanding Office Action sets forth a Restriction Requirement. In accordance with this Restriction Requirement, Applicants elect the compounds of Group I. The claims readable on this elected invention are claims 1 through 24.

Claims 25 through 133, which are withdrawn from further consideration as being directed to the non-elected invention, are not being cancelled. These claims are being retained of record pending the filing of divisional applications directed thereto.

In accordance with a further requirement to elect a specific species, Applicants tentatively elect the species of Example 6 in the captioned application. The compound of Example 6 has the formula 6 on page 72 of the captioned application. In this compound n is 226 so that the polyoxyethylene moiety has a molecular weight of approximately 10,000 Daltons. This is in accordance with the Example 6 as set forth on page 70 of the instant specification. The claims readable on the species of Example 6 are claims 1-3 and 17-20. It is submitted that all of claims 1-24 should be examined in a single application and that the election of species is not proper in view of the generic claims 1-3 which cover all of the species encompassed within Group I.

It is submitted that claims 1-24 should be examined in one application. That an application contains claims which covers two or more possibly divisible inventive species does not make a requirement for restriction or election proper when there is present a properly allowable linking claim generically covering, via a Markush Group, these individual species. As stated in MPEP § 809:

"The linking claims must be examined with, and thus are considered part, of the invention elected. When all claims directed to the elected invention are allowable, should any linking claim be allowable, the restriction requirement between the linked inventions must be withdrawn. " (MPEP pg 800-53, column 2)

Claim 1 is such a linking claim, linking all of the species of Claims 2-24. This linking claim makes these species inseparable from each other. All of these species are embraced within a Markush Group. It is this linking claim which links these inventions which otherwise would be divisible.

Under U.S. Patent law, when an allowable linking claim is present in an application, there is unity of invention and under MPEP §809 no division requirement or election of species is proper. This can be seen by the fact that ,under MPEP § 809.03, where there is a Markush Group linking all of the species, the Examiner in the Office Action when making an election of species is required to utilize form Paragraph 8.01 or 8.02. Both form Paragraphs 8.01 and 8.02 contain the following language:

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. (MPEP §809.02(a)).

Please note, that under MPEP §809.03, once the linking claim is allowed the restriction requirement should be cancelled. Therefore, applicant is allowed to present linking claims in conjunction with the claims directed to these species and have these linking claims examined with the claims directed to the elected species.

Based on the foregoing, it is submitted that the election of species requirement with respect to Group I be withdrawn unless there is a rejection of the linking claims which is in this Group. Therefore, claims 1-24 should be examined on their merits.

Correspondence and Fees

No additional fees are believed to be necessitated by the instant response.

However, should this be in error, authorization is hereby given to charge Deposit Account No. 03-3839 for any underpayment, or to credit any overpayments.

Please address all correspondence to the correspondent address for **Customer No. 26345 of Intellectual Docket Administrator, Gibbons, Del Deo, Dolan, Griffinger & Vecchione**, One Riverfront Plaza, Newark, NJ 07102-5497. Telephone calls should be made to William H. Epstein at (973) 596-4607 or (973) 596-4500 and fax communications should be sent directly to him at (973) 596-0545.

Respectfully submitted,



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